

### **REMARKS**

This Application has been carefully reviewed in light of the Office Action mailed September 29, 2008. At the time of the Office Action, 1-20 were pending in this Application. Claims 1-20 were rejected. Claims 1, 9-11, 19, and 20 have been amended to further define various features of Applicant's invention. Applicant respectfully requests reconsideration and favorable action in this case.

#### **Claim Objections**

Claims 7-10 and 20 were objected due to the recitation of certain phrases, which the Examiner recommended be replaced with alternative language. Applicants have amended Claim 1 by removing the hyphen in "seat-part". Claims 10 and 20 have been redrafted in independent form.

#### **Rejections under 35 U.S.C. § 112**

Claims 1-20 were rejected by the Examiner under 35 U.S.C. §112, second paragraph, as being indefinite and failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant amends Claims 1, 9, 11, and 19 to overcome these rejections and respectfully request full allowance of Claims 1-20 as amended.

A marked-up version of the new set of claims is enclosed, from which the Examiner may take the individual amendments made. Needles of the outward opening type also form part of the invention as described in the application by the embodiment described with reference to Figure 7. The meaning of the cavity being formed in proximity to the sealing area is described in the claims and the description to be radially inwards from the sealing area. Turning to dependent claim 9, it is noted that independent claim 1 recites that "the needle further comprises a seat part." Turning to dependent claim 19, it is noted that independent claim 11 recites that "the needle further comprises a tip." In view hereof and the amended dependent claims 9 and 19 it is clear that the seat part or the tip, respectively, is not differentiated from the needle. Thus, no new matter has been added.

**Rejections under 35 U.S.C. § 102**

Claims 1-4, 6-8, 10-14, 16-18 and 20 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,423,842 issued to James D. Palma (“*Palma*”). Applicant respectfully traverses and submits the cited art does not teach all of the elements of the claimed embodiment of the invention.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “the identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully submits that the cited art as anticipated by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

The Examiner considers that *Palma* discloses all limitations of the independent claims. Applicants respectfully disagree, because the independent claims recites that the cavity (not the material of the valve 73 in *Palma*) makes the seat part flexible.

With reference to claims 1 and 10, *Palma* fails to disclose, at least, that the cavity makes the seat part flexible in the sealing area, and that the cavity is either empty or filled with a material of a suitable stiffness in order to achieve a desired flexibility of the seat part. With reference to claims 11 and 20, *Palma* fails to disclose, at least, that the tip comprises a cavity radially inwards from the sealing area, and that the cavity is either empty or filled with a material of a suitable stiffness in order to achieve a desired flexibility of the tip.

*Palma* discloses a valve 73 having a guide wall 91 interacting with a guide post 90. *Palma*, Figure 2. The guide wall 91 interacting with a guide post 90 provides axial guiding of the valve 73 end. *Palma*, column 8, lines 66-68. *Palma* is silent whether the hole forming the guide wall 91 makes the valve end flexible or not. A reader having ordinary skill in the art must assume not, because otherwise no accurate guiding would take place. While some materials are capable of some degree of flexure, the present independent claims all recites the limitation that the claimed **cavity** makes/achieves flexibility. This differs from the valve body disclosed by *Palma*, where a hole is made for guidance purpose. Again, the guide wall

91 and the guide post 90 does not allow for flexibility, because this would not provide the required guiding of the valve 73 end.

The rejection under 35 U.S.C. §102 is respectfully traversed because of the amended set of claims filed. Since *Palma* fails to disclose, at least, that the cavity makes the seat part flexible in the sealing area, or that the tip comprises a cavity radially inwards from the sealing area, and that the cavity is either empty or filled with a material of a suitable stiffness in order to achieve a desired flexibility of the seat part or tip, it is respectfully requested that the rejection under 35 U.S.C. §102 is withdrawn. Applicants respectfully submit that the dependent Claims are allowable at least to the extent of the independent Claim to which they refer, respectively. Thus, Applicants respectfully request reconsideration and allowance of the dependent Claims. Applicants reserve the right to make further arguments regarding the Examiner's rejections under 35 U.S.C. §102, if necessary.

### **Rejections under 35 U.S.C. §103**

Claims 5, 9, 15 and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Palma*.

Claims 1, 3-4, 6-7, 10-11, 13-14, 16-17 and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,338,445 issued to Malcolm David Dick Lambert et al. ("*Lambert*") in view of U.S. Patent No 6,631,854 issued to Hubert Stier ("*Stier*").

Applicant respectfully traverses and submits the cited art combinations, even if proper, which Applicant does not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must

be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on ex post reasoning. *KSR*, 127 S.Ct. at 1742. In addition, evidence that such a combination was uniquely challenging or difficult tends to show that a claim was not obvious. *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc. and Mattel, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007), citing *KSR*, 127 S.Ct. at 1741.

With reference to claims 1 and 10, *Lambert* fails to disclose, at least, that the cavity makes the seat part flexible in the sealing area, and that the cavity is either empty or filled with a material of a suitable stiffness in order to achieve a desired flexibility of the seat part. With reference to claims 11 and 20, *Lambert* fails to disclose, at least, that the tip comprises a cavity radially inwards from the sealing area, and that the cavity is either empty or filled with a material of a suitable stiffness in order to achieve a desired flexibility of the tip.

The Examiner considers the deformation of the region 12b to make the seat part flexible and refers to *Lambert*, column 9, lines 55-60. Applicant respectfully disagrees, because, for the same reason as above for *Palma*, the cavity (not the deformation of the region 12b in *Lambert*) makes the seat part or tip flexible. It is the specific shape of the region 12b and this regions deformation that causes the sealing, not a flexibility created by a cavity in the valve needle 12. *Lamber*, column 8, lines 26-47. However, with reference to another embodiment, Applicant notes that *Lambert* discloses that the region 12b may deform inwardly cooperating with the region 18a of the inner valve needle 18. It is the seal formed between the region 18a of the inner valve needle 18 and the region 12b of the outer valve needle 12 that closes the clearance 27 and any fuel cannot therefore escape through clearance 27. *Lambert*, column 10, lines 26-35. This differs from the claimed limitations in the independent claims reciting that the cavity is either empty or filled with a material of a suitable stiffness in order to achieve a desired flexibility of the seat part. In *Lambert* the cavity is filled with the inner valve needle 18. *Lambert* is silent with respect to the inner valve needle 18 having a suitable stiffness of in order to achieve a desired flexibility of the region 12b. *Stier* does not fill this difference, because no cavity in the valve-closure member 8 is present.

The rejection under 35 U.S.C. §103(a) is respectfully traversed because of the amended set of claims filed. Since *Lambert* and *Stier* fail to teach or suggest that the cavity is either empty or filled with a material of a suitable stiffness in order to achieve a desired flexibility of the seat part or tip, it is respectfully requested that the rejection under 35 U.S.C. §103(a) is withdrawn. Applicants respectfully submit that the dependent Claims are allowable at least to the extent of the independent Claim to which they refer, respectively. Thus, Applicants respectfully request reconsideration and allowance of the dependent Claims. Applicants reserve the right to make further arguments regarding the Examiner's rejections under 35 U.S.C. §103(a), if necessary, and do not concede that the Examiner's proposed combinations are proper.

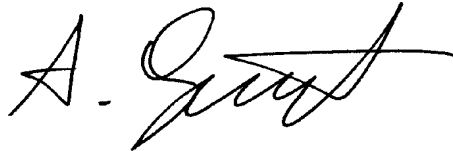
**CONCLUSION**

Applicant has made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicant respectfully requests reconsideration of the pending claims.

Applicant believes there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.322.2545.

Respectfully submitted,  
BAKER BOTTS L.L.P.  
Attorney for Applicant

A handwritten signature in black ink, appearing to read 'A. Grubert', with a stylized flourish at the end.

Andreas Grubert  
Registration No. 59,143

Date: December 24, 2008

**SEND CORRESPONDENCE TO:**

BAKER BOTTS L.L.P.

CUSTOMER ACCOUNT NO. **31625**

512.322.2545

512.322.8383 (fax)